

REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-24 are pending. New claims 23 and 24 have been added to secure an appropriate scope of protection to which Applicants are believed entitled. Claims 1 and 17 have been amended to specify that the service system performs the identifying step based on session information of the current communication sessions.

Applicant traverses the rejection of claims 1-5, and 7-20, and 22 under 35 U.S.C. 102(e) as being anticipated by Porter (U.S. 6,434,599).

Amended independent claim 1 is directed to a method of establishing communication over a data network between endpoint systems using a service system that can set up a communication session with an associated transport mechanism enabling the exchange of data between endpoint systems joined to the session by the service system. The method includes a combination of steps, including processing a communication request received at the service system on the basis of information associated with the request. Processing is effected by (1) identifying by the service system an appropriate session for the communication requested from a pool of current communication sessions based on session info of the current common sessions and, where no appropriate session currently exists, creating a new appropriate session, and (2) identifying, from a pool of available parties, a specific party and associated endpoint system to join the session identified or created in step (a).

Amended independent claim 17 is directed to a service system having a combination of features, including a session entity for establishing communication sessions and controlling the joining of endpoint entities to each communication session; a transport entity for establishing a

transport mechanism for each session established by the session entity, the transport mechanism being arranged for allowing the exchange of data across a network between endpoint entities joined to the session; and request-handling means for receiving and processing a communication request to join a requesting endpoint entity into an appropriate session with another endpoint entity on the basis of information associated with the request. The request-handling means includes session-routing means for identifying, from a pool of current communication sessions, an appropriate session for the communication requested based on session info of the current common sessions and, where no appropriate session currently exists, creating a new appropriate session, and participant-routing means for identifying, from a pool of available parties, a specific party and associated endpoint system to join the session identified or created by the session-routing means.

A rejection based on 35 U.S.C. §102 requires that every element of the claim be included in the reference, either directly or inherently. Porter does not disclose all elements of Applicant's independent claims 1 and 17 as required by 35 U.S.C. §102.

Porter fails to disclose at least the service system identifying an appropriate session for the communication requested based on session information of the current communication sessions. The Examiner appears to have ignored the claim language of step (a) requiring identification of an appropriate session. As previously described, Porter merely describes a system for polling users regardless of the appropriateness of the session to ascertain whether any of the users wish to participate in a chat session. See column 4, line 55, through column 5, line 22 of Porter. The Examiner is requested to identify a teaching in Porter, preferably by column and line number, of identification of an appropriate session from a pool of communication sessions based on session information as claimed in the present claimed subject matter. As Porter fails to disclose identifying an appropriate session for the communication requested, claim 1 is patentable over Porter and a notice of allowance is in order.

Further, the Examiner admits that in Porter the users receiving chat invitations decide whether to join a chat session. See the FOA at page 9, section 5.(a) "other users decide whether to consent to a chat session" and page 10, section 5.(b) "users decide whether they would like to consent to chat with the initiating user." In the Porter system, the existing chat participants, through acceptance or rejection of a new visitor, determine the chat session to which the new visitor is joined and which parties are in the session with the new visitor. Porter fails to disclose a service system identifying an appropriate session for the communication requested.

For one or both of the foregoing reasons, claim 1 is patentable over Porter and a notice of allowance is in order.

Claims 2-5, 7-16, 18-20, and 23-24 depend, either directly or indirectly, from claims 1 and 17, include further important limitations, and are patentable over Porter for at least reasons similar to the reasons advanced above with respect to claim 1. A notice of allowance with respect to claims 2-5, 7-16, 17-20, and 23-24 is in order.

With further specific reference to claims 7 and 9 and notwithstanding the Examiner's several citations to differing locations in Porter, Porter fails to disclose a service-session functional entity as required by dependent claims 7 and 9. The cited portions of Porter describe the establishment of a chat session without specifying creation of a service session functional entity. The Examiner is reminded of the standard to be met in order to assert that a feature is inherent. In order to rely upon a theory of inherency, the Examiner is required to provide a factual basis and/or technical reasoning reasonably supporting the determination that the allegedly inherent characteristic **necessarily** flows from the prior art teaching. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). "The mere fact that a certain thing **may** result from a given set of circumstances **is not sufficient**." In re Robertson, 169 F.3d 743,

745, 49 USPQ3d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present." Rosco v. Mirror Lite, 304 F.3d 1373, 1380 (Fed. Cir. 2002). The Examiner has failed to meet the burden and a notice of allowance is in order.

As the Examiner has failed to respond to Applicant's traversal of the asserted combination of Porter in view of Cave, the Examiner is specifically requested to address Applicant's arguments (reprinted herein below for ease of reference) or issue a notice of allowance with respect to claims 6 and 21.

Claims 6 and 21 depend respectively from allowable independent claims 1 and 17 and are allowable for at least the same reasons, since Cave fails to cure the deficiencies of Porter as a primary reference. Withdrawal of the rejection of claims 6 and 21 based on Porter and Cave is, therefore, in order.

Further, the Office Action fails to identify any teaching, suggestion, or motivation to combine Porter with Cave. According to the Office Action, it would have been obvious to one of ordinary skill in the art at the time of the present invention to combine Porter with Cave in order to "connect the user to the next available agent for bi-directional data exchange." This assertion notwithstanding, the Office Action does not point out any satisfactory motivation or suggestion in either reference to support the asserted combination. The Office Action appears to improperly apply hindsight reasoning based on the present invention to make the asserted combination. The rationale that the references are from a similar area ("in an analogous art") does not explain why the combination would have been obvious to a person of ordinary skill in the art or why such a person would have been motivated to combine the references.

Merely stating that combining prior art references to meet a claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01 quoting *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993). The Office Action does not

state any desired result that flows from the combination. Accordingly, the Office Action fails to supply sufficient objective reasons to combine Porter and Cave.

The Office Action does not identify any teaching in Porter or Cave motivating a person of ordinary skill in the art to make, or suggesting, the asserted combination, nor does the Office Action provide an affidavit, perhaps because there is no teaching to be found. For at least this reason, the rejection of claims 6 and 21 based on Porter and Cave should be withdrawn. However, if the rejection is maintained, the Examiner is respectfully requested, in accordance with MPEP §2143.01 and *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), to identify a teaching, suggestion, or motivation in either reference or to provide an affidavit of facts within the Examiner's personal knowledge per MPEP §2144.03 providing motivation or a suggestion to one of ordinary skill in the art to make the proposed combination.

"When an obviousness determination is based on multiple prior art references, there must be a showing of some 'teaching, suggestion, or reason' to combine the references." Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The Office Action fails to make such a showing for supporting the applied combination of references; therefore, the applied combination of references is improper. For this additional reason, the rejection of claims 6 and 21 should be withdrawn.

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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